

**Application No.:** 10/507,923  
**Filing Date:** July 19, 2005

### **REMARKS**

Applicants wish to thank Examiner Hill for the time and courtesy extended to Applicants' representative during the personal interview of October 19, 2009. The substance of the interview is set forth in the Summary of Interview above and the Interview Summary mailed October 22, 2009.

Claims 15, 16 and 18-42 are currently pending. Claims 1-14 and 17 are canceled without prejudice or disclaimer. Claims 19-21, 29-33 and 37-40 are indicated as withdrawn. Applicants reserve the right to pursue the subject matter of any canceled or withdrawn claims in one or more continuing applications. Currently claims 15, 16, 18, 22-28, 34-36, 41 and 42 have been examined.

Claims 15, 26, 28, 36 and 42 are amended. Support for the amendments to each of these claims can be found in the claims and specification as originally filed. In particular, support for the amendments to claim 15 can be found in the specification at paragraphs [0019] and [0020] as well as elsewhere throughout the specification as originally filed. Dependent claims 26, 36 and 42 are amended to maintain consistency with independent claim 15. Dependent claim 28 is amended to improve clarity. Accordingly, the current amendments do not constitute the addition of new matter.

#### Rejection of claim 28 under 35 U.S.C. § 112, second paragraph

The Examiner rejects claim 28 under 35 U.S.C. § 112, second paragraph as allegedly indefinite. In particular, the Examiner asserts that the use of the phrase "the selectable marker" lacks antecedent basis.

Applicants have amended claim 28 to recite, in relevant part, the "eucaryote cell according to claim 15, further comprising a selectable marker."

In view of the foregoing amendment, Applicants request that the Examiner withdraw the above rejection of claim 28 under 35 U.S.C. § 112, second paragraph.

#### Rejection of claims 15, 16, 18, 22-26, 28, 34, 36, 41 and 42 under 35 U.S.C. § 102(a) and (e)

The Examiner rejects claims 15, 16, 18, 22-26, 28, 34, 36, 41 and 42 under 35 U.S.C. § 102(a) and (e) as allegedly anticipated by U.S. Patent No. 6,271,359 (Norris et al.). In

particular, the Examiner asserts that Norris et al. disclose every element of each of the above-rejected claims. Applicants do not agree.

Although Applicants maintain that claims 15, 16, 18, 22-26, 28, 34, 36, 41 and 42 were not anticipated by Norris et al prior to the current amendments, in order to expedite allowance of the instant claim set, Applicants have amended claim 15, in relevant part, to further recite "an additional construct comprising a nucleic acid to be integrated into the first construct and a nucleic acid sequence which facilitates recombination with a nucleic acid sequence in said first construct, wherein recombination between said first construct and said additional construct prevents toxicity of said first construct." As agreed during the interview of October 19, 2009, Norris et al. do not disclose a cell comprising both a genetic construct incorporated in the genome of a cell and an additional construct as recited in independent claim 15. For at least the foregoing reason, Norris et al. do not disclose the cells set forth in any of the above-rejected claims.

In view of the foregoing remarks and amendment, Applicants respectfully request that the Examiner withdraw the rejection of claims 15, 16, 18, 22-26, 28, 34, 36, 41 and 42 under 35 U.S.C. § 102(a) and (e).

Rejection of claims 15, 16, 18, 22-28, 34-36, 41 and 42 under 35 U.S.C. § 103(a)

The Examiner rejects claims 15, 16, 22-26, 34-36 and 41 under 35 U.S.C. § 103(a) as allegedly obvious over Kristoffersen et al. in view of Parekh et al. Furthermore, the Examiner rejects claims 18, 28 and 42 as allegedly obvious over the combination of Kristoffersen et al. and Parekh et al. in view of Norris et al and Pecota et al. Finally, the Examiner rejects claim 27 as allegedly obvious over the combination of Kristoffersen et al., Parekh et al, Norris et al. and Pecota et al. in view of Newman et al. and in further view of Rochaix et al. With respect to claims 15, 16, 22-26, 34-36 and 41, the Examiner asserts that Kristoffersen et al. disclose introduction of genetic sequences encoding poison and antidote proteins into yeast. The Examiner acknowledges that Kristoffersen et al. do not disclose integration of the sequence encoding the poison protein into the yeast genome. The Examiner, however, asserts that Parekh et al. disclose yeast integrative vectors. The Examiner then contends that a skilled artisan would be motivated to combine the integrative vectors of Parekh et al. because the integrative vector

would be stably propagated to progeny cells. The Examiner also contends that there would be a reasonable chance of success because such a substitution allegedly would lead to results predictable to those of ordinary skill in the art. With respect to claims 18, 28 and 42, the Examiner alleges that Norris et al. disclose the additional element of using CcdB/CcdA as a poison/antidote system, that a skilled artisan would be motivated to use such a system in place of RelE/RelB in order to optimize the transformation and stable propagation of the transformation vector, and that a simple substitution of these known elements would yield predictable results. The Examiner also asserts that Pecota et al. disclose a selectable marker bordered by two toxic genes. Finally, with respect to claim 27, the Examiner asserts that Newman et al. disclose the additional element of using a chloroplast integrating transformation vector, that a skilled artisan would be motivated to use such a vector in place of the nuclear integrating vector allegedly disclosed by Parekh et al. in order to optimize the transformation and stable propagation of the transformation vector, and that a simple substitution of these known elements would yield predictable results.

Although Applicants maintain that, prior to the current amendments, claims 15, 16, 18, 22-28, 34-36, 41 and 42 were not obvious over any combination of the above-recited references, in order to expedite allowance of the instant claim set, Applicants have amended claim 15, in relevant part, to further recite "an additional construct comprising a nucleic acid to be integrated into the first construct and a nucleic acid sequence which facilitates recombination with a nucleic acid sequence in said first construct, wherein recombination between said first construct and said additional construct prevents toxicity of said first construct. None of the above-cited references, alone or in combination, disclose or suggest a cell comprising both a genetic construct incorporated in the genome of a cell and an additional construct as recited in independent claim 15. For at least the foregoing reason, the above-rejected claims are not obvious over the above-cited art.

In view of the foregoing remarks and amendments, Applicants respectfully request that the Examiner withdraw the rejection of claims 15, 16, 18, 22-28, 34-36, 41 and 42 under 35 U.S.C. § 103(a).

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Provisional rejection of claims 15, 16, 18, 22-24, 26, 35 and 36 under the doctrine of obviousness-type double patenting

The Examiner provisionally rejects claims 15, 16, 18, 22-24, 26, 35 and 36 under the judicially created doctrine of obviousness-type double patenting. In particular, the Examiner alleges that these claims are not patentably distinct from claims 1-3, 9-10, 13-16 and 22 of U.S. Patent Application No. 11/558,856 (the '856 application).

Applicants submit that claims 15, 16, 18, 22-24, 26, 35 and 36 are patentably distinct from the claims of the '856 application. In particular, the claims of the '856 application do not teach or suggest a cell comprising both a genetic construct incorporated in the genome of a cell and an additional construct as recited in amended claim 15. Accordingly, claims 15, 16, 18, 22-24, 26, 35 and 36 are patentably distinct from the claims of the '856 application.

Applicants would like to bring to the Examiner's attention that the '856 application issued as U.S. Patent No. 7,595,185 on September 29, 2009.

In view of the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of claims 15, 16, 18, 22-24, 26, 35 and 36 as obvious in view of the claims of the '856 application.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

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### **CONCLUSION**

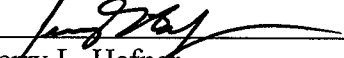
Applicants believe that all outstanding issues in this case have been resolved and that the present claims are in condition for allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is invited to contact the undersigned at the telephone number provided below in order to expedite the resolution of such issues.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By:   
Jerry L. Hefner  
Registration No. 53,009  
Attorney of Record  
Customer No. 20995  
(619) 235-8550

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